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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,994	08/09/2000	Howard Demehl	DERN-00101	5407
28960 7590 07/03/2007 HAVERSTOCK & OWENS LLP 162 N WOLFE ROAD SUNNYVALE, CA 94086			EXAMINER ALVAREZ, RAQUEL	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/635,994

Applicant(s)

DERNEHL ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41 and 43-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12, 13, 15-21, 23, 27-30, 34-36, 40, 41 and 43-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to communication filed on 4/2/2007.
2. Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41 and 43-51 are presented for examination.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 6-10, 12-13, 15-21, 23, 27-30, 34-36, 40, 41 and 43-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over **article titled, "recommend-it.com"** in view of "How MileNet Works" hereinafter MileNet .

With respect to claims 1-4, 7-13, 15-16, 19, 27, 30, 34-35, 40-41, 43-45, 50-51, recommend it.com teaches a method of marketing comprising the steps of a first party recommending a marketable entity, the recommendation comprising forwarding of a first e-mail message to a second party, the first message comprising a personalized referral for the marketable entity and a first set of data, the first set of data comprising a first serial number and a first URL link to a first web site having an offer to transact for the marketable entity (i.e. the first user will send an e-mail to a friend or colleague detailing the site and would include a short description identifying the recommended software and personal annotation)(page 2); correlating the first set of data in the first e-mail

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message to data within a database (page 2); updating the database with an e-mail address of a second party provided by the first party (pages 1-4); forwarding the first e-mail message to the e-mail address of the second party (see page 4).

With respect to the marketable entity being selected from a group consisting of goods and services. Recommend.it.com teaches recommending a particular software called WebDeck. Recommend.it.com doesn't specifically teach selecting from a group of goods or services. Official Notice is taken that it is old and well known to allow users to select different products or services in order to provide variety. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included selecting from a group consisting of goods and services in order to achieve the above mentioned advantage.

With respect to providing data related to a reward and providing the reward to the first party if the second party transacts the exchange from the marketable entity. MileNet teaches a pyramid type of incentive wherein the first user will increase their MileNet points based on friends and family installing and using Milenet. By the second user using and installing MileNet in essence, he is transacting or performing an activity at the website. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included providing data related to a reward and providing the reward to the first party if the second party transacts the exchange from the marketable entity in order to motivate the users to increase their rewards based on their friends and families actions.

Claims 46-49 have been amended to further recite the first purchasing the marketable entity and then recommending the purchased marketable entity. The combination of Recommend-it.com and MileNet teach a first user using and installing software and then recommending it to a second user. The combination of Recommend-it.com and MileNet do not teach purchasing the marketable entity. It would have been obvious in the combination of Recommend-it.com and MileNet for the first user to have bought the item and then to have recommend it to a second person because such a modification would allow the companies to benefit from selling their product or services

Claims 6, 17-18, 20, further recite that the link is accessible through a token in the form of a first icon visible in the message. Official notice is taken that it is old and well known in the computer related field to have a token in the form of an icon that is visible in the message in order to represent a function, object or program. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included a token in the form of a first icon visible in the message in order to make file navigations and manipulation easier.

Claims 21-23, 28-29, 36 further recite crediting an account within a database and recording the reward credited. Official notice is taken that it is old and well known in the business related arts to credit an account because such a modification would provide an easy and efficient way to reward a customer. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included crediting an

account within a database and recording the reward credited in order to obtain the above mentioned advantage.

**Response to Arguments**

5. Applicant argues that Recommend-it.com does not teach a recommendation that includes an offer to transact an exchange where the offer is included within the recommendation itself. The Examiner disagrees with Applicant because Recommend-it.com teaches the recommendation being in the form of an e-mail sent to the second user detailing the software called WebDeck”.

6. Applicant argues that Recommend-it.com does not teach offering a reward in exchange for a recommendation. The Examiner wants to point out that Recommend-it.com wasn't cited for teaching the limitation but MileNet was the reference cited for teaching a pyramid type of incentive wherein the first user will increase their MileNet points based on friends and family installing and using Milenet.

7. With respect to claim amendment pertaining to claim 46, see above rejection.

8. With respect to the Official notice taken, Applicant didn't provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of, the Official notice is sustained. See MPEP 2144.03 where In re Boon is mentioned.

**Conclusion**

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

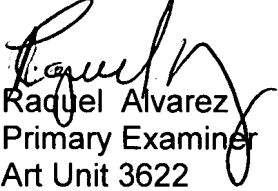
**Point of contact**

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (571)272-6715. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w. Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Raquel Alvarez  
Primary Examiner  
Art Unit 3622

R.A.  
6/12/2007